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EXAMINER

CANTELMO, GREGG

ART UNIT

PAPER NUMBER

1745

DATE MAILED: 08/20/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/975,230	BRUNO, MERONI
Examiner	Art Unit	
Gregg Cantelmo	1745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 07 August 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 23-39 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 23-39 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. In response to the amendment received August 7, 2003:
  - a. Claims 15-19 and 22 have been cancelled;
  - b. Claims 23-39 are pending.

### ***Specification***

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the specification does not recite that the tray is adapted to allow deformation at the ambient atmosphere by bringing the bottom wall and the projecting edge of the later wall towards each other (limitations found in claim 39).

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claim 39 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had

possession of the claimed invention. Claim 39 recites that the tray is adapted to allow deformation at the ambient atmosphere by bringing the bottom wall and the projecting edge of the later wall towards each other. The original disclosure does not teach of this and therefore is held to be new matter.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 23-34, 37 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. patent No. 4,045,153 (Maurino), of record and for the reasons of record.

Maurino discloses a flexible mould FM' comprising: a flexible tray made of silicone and having an outward projecting edge 4, the tray having a stiffening element 7 adjacent the projecting edge adapted to stiffen the projecting edge and improve the handling of the tray by the edge, while retaining flexibility of the tray, said flexibility together with the stiffening element provided for flattening the tray (Fig. 2 and col. 3, ll. 1-3, 5, and 23-32 as applied to claim 23). With regards to the functional recitations in claim 23: Maurino discloses the same tray arrangement as recited in claim 23. The materials (silicone tray and stiffening element 7) are disposed in the same relative manner as recited in claim 23. Thus since the prior art has the same structural

configuration and is formed of the same materials as in the instant application, there is a reasonable expectation that the prior art tray will function in the same manner as that of the instant claim.

The stiffening element 7 is embedded in the projecting edge 4 (Fig. 2 as applied to claim 24).

The edge 4 is provided with an opening wherein the stiffening element 7 is disposed. Element 7 sits in this opening and thus the opening is held to be a seat (Fig. 2 as applied to claim 25).

The edge 4 overlaps the stiffening element 7 so as to hold it in the seating orifice (Fig. 2 as applied to claim 26).

The stiffening element 7 traverses the entire edge 4 and thus is held to be a frame within which lies the interior of the tray (as applied to claim 27).

The stiffening element is plastic which is disposed around the edge of the tray thereby framing the interior portion of the tray (col. 3, ll. 25-32 as applied to claims 28 and 29). No patentable weight is accorded to the process of applying the plastic element since the claimed invention is drawn to the product and not the method of making. Since the prior art has the same structural arrangement as the instant claims and is formed of the same materials, the prior art is held to anticipate the product-by-process claim of claims 28 and 29.

Maurino discloses a flexible mould FM' comprising: a flexible tray made of silicone and having an outward projecting edge 4, the tray having a stiffening element 7 adjacent the projecting edge adapted to stiffen the mold and give the mold the

resistance to carry the weight of a product disposed therein without being deformed while keeping its flexibility, said stiffening means consisting of a stiffening element 7 included in the projecting edge 4 of the tray (Fig. 2 and col. 3, ll. 1-3, 5, and 23-32 as applied to claim 30). With regards to the functional recitations in claim 30: Maurino discloses the same tray arrangement as recited in claim 30. The materials (silicone tray and stiffening element 7) are disposed in the same relative manner as recited in claim 30. Thus since the prior art has the same structural configuration and is formed of the same materials as in the instant application, there is a reasonable expectation that the prior art tray will function in the same manner as that of the instant claim.

The stiffening element 7 is embedded in the projecting edge 4 (Fig. 2 as applied to claim 31).

The edge 4 is provided with an opening wherein the stiffening element 7 is disposed. Element 7 sits in this opening and thus the opening is held to be a seat (Fig. 2 as applied to claim 32).

The stiffening element 7 traverses the entire edge 4 and thus is held to be a frame within which lies the interior of the tray (as applied to claim 33).

Maurino discloses a flexible mould FM' comprising: a flexible tray made of silicone and having an outward projecting edge 4, the tray having a stiffening element 7 adjacent the projecting edge. The edge 4 is provided with an opening wherein the stiffening element 7 is disposed. Element 7 sits in this opening and thus the opening is held to be a seat (Fig. 2 as applied to claim 34).

The stiffening element is plastic which is disposed around the edge of the tray thereby framing the interior portion of the tray (col. 3, ll. 25-32 as applied to claim 37). No patentable weight is accorded to the process of applying the plastic element since the claimed invention is drawn to the product and not the method of making. Since the prior art has the same structural arrangement as the instant claims and is formed of the same materials, the prior art is held to anticipate the product-by-process claim of claim 37.

Maurino discloses a flexible mould FM' comprising: a flexible tray made of silicone and having an outward projecting edge 4, the tray having a stiffening element 7 adjacent the projecting edge adapted to allow the tray to be deformed flat at the ambient atmosphere by bringing the bottom wall and the projecting edge of the lateral wall towards each other (Fig. 2 and col. 3, ll. 1-3, 5, and 23-32 as applied to claim 39).

With regards to the functional recitations in claim 39: Maurino discloses the same tray arrangement as recited in claim 39. The materials (silicone tray and stiffening element 7) are disposed in the same relative manner as recited in claim 39. Thus since the prior art has the same structural configuration and is formed of the same materials as in the instant application, there is a reasonable expectation that the prior art tray will function in the same manner as that of the instant claim.

### ***Response to Arguments***

7. Applicant's arguments filed August 7, 2003 have been fully considered but they are not persuasive.

Applicant argues that the mold is structurally different than the tray of the instant claims since it cannot be flattened.

Applicant appears to base this argument on the manner in which Maurino uses the mold. More particularly that the mold of Maurino is designed to stretch in the presence of a vacuum and not flatten as claimed by applicant.

Note this argument does not pertain to claims 30-38 since these claims fail to recite this functional limitation.

In so far as this argument is applied to the claims which recite such a functional limitation, *Applicant does not provide clear evidence that the prior art of record cannot provide the claimed function.*

The basis that the prior art does not anticipate the claimed invention merely because the manner in which it operated is different does not provide convincing evidence that the prior art tray, which has the same structural arrangement and material composition as the claimed invention, cannot function in the manner recited in the instant claims. As has been set forth by the Examiner over the course of prosecution history"

While intended use recitations and other types of functional language cannot be entirely disregarded. However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference

as compared to the prior art. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963).

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). See also MPEP § 2114.

The manner of operating the device does not differentiate an apparatus claim from the prior art. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

For the reasons set forth above, the prior art of record is held to anticipate the instant claims.

#### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 35, 36 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maurino in view of U.S. Patent No. 3,981,656 (Steels).

The teachings of Maurino have been discussed above and are incorporated herein.

Maurino discloses a flexible mould FM' comprising: a flexible tray made of silicone and having an outward projecting edge 4, the tray having a stiffening element 7 adjacent the projecting edge (as applied to claim 34).

The edge has a part which encases the stiffening element and therefore overlaps part of the stiffening element to be held within the space defined by the stiffening element (as applied to claim 36).

Maurino does not teach of the seat being provided at the lower surface of the edge (claim 35),

Steels discloses that it is known to provide a stiffening element 7 at a lower surface of edge 1 (Fig. 2 as applied to claim 35). The edge overlaps a part of the frame 7 so as to hold it in place (Fig. 2 as applied to claim 36). The stiffening element and seat comprises a rectangular cross-section (Fig. 2 as applied to claim 38).

The motivation for using the configuration of Steels is that it provides and alternative and equivalent means for supporting a flexible mould (col. 2, ll. 11-12). One of ordinary skill in the art would have found it obvious to use either support means for the mould of Maurino and as evident from the instant application, various stiffening element configurations provide equivalent means for support. Thus there is no criticality of one arrangement over the other and appear to be obvious variants.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of Maurino by using the

edge/stiffening element configuration of Steels since it would have provided an alternative and equivalent means for supporting a flexible tray.

***Response to Arguments***

10. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregg Cantelmo whose telephone number is (703) 305-

0635. The examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan, can be reached on (703) 308-2383. FAX communications should be sent to the appropriate FAX number: (703) 872-9311 for After Final Responses only; (703) 872-9310 for all other responses. FAXES received after 4 p.m. will not be processed until the following business day. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Gregg Cantelmo  
Patent Examiner  
Art Unit 1745

gc

  
Patrick Ryan  
Supervisory Patent Examiner  
Technology Center 1700

August 18, 2003